

*KDZ*

pencil, a stick for dyeing locks of hair, or a stick for making up locks of hair comprising a solid composition with an aqueous continuous phase comprising i) at least one hydrophilic gelling agent present in a concentration of less than 20% by weight of the composition and ii) at least one pulverulent phase comprising at least one lamellar filler, wherein said composition has a hardness, defined by a maximum force before breaking, ranging from 5 to 130 grams, at ambient temperature, after penetration with a stainless steel spindle 2 mm in diameter into the matrix of the composition to a depth of 1 mm at a speed of 1 mm/s and removal of said spindle from the matrix of the gel at a speed of 2 mm/s. - -

In accordance with the requirements of 37 C.F.R. § 1.121, the attached Appendix shows the changes to the specification and claims that have been made by the proposed amendment.

### REMARKS

#### **Status of the Claims**

Claims 30-85 are pending. Claims 31, 32, 34, 35, 37-40, 51-59, 70-74, and 86-88 have been withdrawn by the Examiner, as being drawn to non-elected subject matter. Claims 30, 33, 36, 41-50, 60, 63-69, and 77-85 are rejected under 35 U.S.C. §102(b). (Office Action, pages 2-3.) Claims 30, 33, 36, 41-50, 60-69, and 75-85 were also rejected under 35 U.S.C. §103(a). (*Id.*, pages 3-4.)

Applicants have amended claims 30 and 83-85 solely to more particularly describe the subject matter claimed therein. Support for the claim amendments is found in the specification and in all priority documents, such as in original claim 5. No new matter has been added with these claim amendments.

I. **The Claims Are Not Anticipated Under 35 U.S.C. § 102**

The Office has rejected claims 30, 33, 36, 41-50, 60, 63-69, and 77-85 under 35 USC§ 102(b) as being anticipated by *Roulier et al.*, WO 97/17055 ("Roulier"), for the reasons set forth on pages 2-3 of the Office Action. Applicants traverse the rejection because *Roulier* does not teach all the limitations of the instant claims as amended. With entry of the above amendment, all pending claims include the limitation that the at least one hydrophilic gelling agent is "present in a concentration of less than 20% by weight of the composition." An anticipation rejection under §102 requires that the cited reference disclose all the limitations of the claimed invention. *Roulier's* composition comprises the hydrophilic gelling agent at a concentration that is greater than the claimed amount. See *Roulier*, abstract and page 17, claim 1. Accordingly, *Roulier* does not anticipate the claimed invention because *Roulier* does not teach all of the limitations of the instant claims. Applicants respectfully request reconsideration and withdrawal of the rejection.

III. **The Claims Are Not Obvious Under 35 U.S.C. § 103 *Roulier***

The Office has rejected claims 30, 33, 36, 41-50, 60-69, and 75-85 under 35 USC§ 103(a) as being obvious over *Roulier*, for the reasons set forth on pages 3-4 of the Office Action. Applicants respectfully traverse the rejection.

To establish a prima facie case of obviousness, an Examiner must meet three basic criteria, including that, (1) the prior art reference must teach or suggest all the claim limitations and (2) there must be some motivation in the art to modify the reference. In the present case, the Examiner has failed to make a prima facie case of obviousness because at least these two criteria have not been met.

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Applicants traverse the rejection because *Roulier* does not teach all the limitations of the instant claims as amended. As emphasized above, all pending claims include the limitation that the at least one hydrophilic gelling agent is "present in a concentration of less than 20% by weight of the composition." An obviousness rejection under §103 requires that the cited reference teach or suggest all the limitations of the claimed invention. *Roulier's* composition comprises the hydrophilic gelling agent at a concentration of greater than the concentration claimed. See *Roulier*, abstract and page 17, claim 1 where an amount of "at least 20%" is disclosed. Accordingly, *Roulier* does not teach all of the limitations of the instant claims. *Roulier* also does not suggest the claimed concentration because, for example, the reference teaches away from the claimed amount of hydrophilic gelling agent by requiring at least 20%. There exists no teaching in the reference suggesting less than 20% hydrophilic gelling agent. Thus, *Roulier* neither teaches nor suggests all the limitations of the instant claims.

In addition, in order to establish a *prima facie* case of obviousness there must be some motivation in the art to modify the reference. Applicants also submit that there is nothing in *Roulier* to provide motivation to modify *Roulier's* composition to devise the claimed invention. For example, there is nothing in *Roulier* to suggest modifying the concentration of gelling agent to be less than 20%. In fact, as stated above, *Roulier* teaches away from such an amount by requiring more than Applicants' claimed amount; and *Roulier* requires at least 20% gelling agent.

Accordingly, the Office has failed to show a *prima facie* case of obviousness according to MPEP § 2143 because of at least one of the following reasons: (1) *Roulier* does not teach or suggest all of the limitations of the instant claims; and (2) since the compositions of *Roulier* require more than gelling agent, there would therefore have

been no motivation to make the Examiner's suggested modification to arrive at the compositions of the present invention which comprise a hydrophilic gelling agent at a concentration of less than 20% by weight of the composition. Applicants respectfully request that the rejection be reconsidered and withdrawn.

**III. Allowable Subject Matter**

The Examiner states that claims limited to elected species 1-10 as set forth in the Response to Election of Species filed October 23, 2002, would be allowable. (Office Action, page 4.) In view of the Applicants' amendments and remarks made above, Applicants submit that Claims 30, 33, 36, 41-50, 60-69, and 75-85 are in condition for allowance. Accordingly, Applicants respectfully request that the Office reconsider and withdraw its objection to the instant claims 30, 33, 36, 41-50, 60-69, and 75-85.

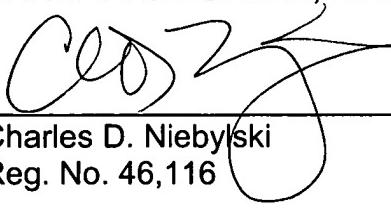
**CONCLUSION**

Applicants therefore respectfully request reconsideration of the application, and the timely allowance of the pending claims. Please grant any extensions of time required to enter this amendment and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By:

  
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Reg. No. 46,116

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**APPENDIX SHOWING AMENDMENTS MADE**

**IN THE CLAIMS:**

Please amend claims 30 and 83-85 as follows:

--30. (Amended) A solid composition comprising an aqueous continuous phase comprising i) at least one hydrophilic gelling agent present in a concentration of less than 20% by weight of the composition and ii) at least one pulverulent phase comprising at least one lamellar filler, wherein said composition has a hardness, defined by a maximum force before breaking, ranging from 5 to 130 grams, at ambient temperature, after penetration with a stainless steel spindle 2 mm in diameter into the matrix of the composition to a depth of 1 mm at a speed of 1 mm/s and removal of said spindle from the matrix of the gel at a speed of 2 mm/s.

83. (Amended) A makeup product for the skin and/or keratinous fibers, comprising a solid composition with an aqueous continuous phase comprising i) at least one hydrophilic gelling agent present in a concentration of less than 20% by weight of the composition and ii) at least one pulverulent phase comprising at least one lamellar filler, wherein said composition has a hardness, defined by a maximum force before breaking, ranging from 5 to 130 grams, at ambient temperature, after penetration with a stainless steel spindle 2 mm in diameter into the matrix of the composition to a depth of 1 mm at a speed of 1 mm/s and removal of said spindle from the matrix of the gel at a speed of 2 mm/s.

84. (Amended) A makeup product for the skin and/or keratinous fibers, comprising a composition comprising a continuous aqueous phase comprising a solid

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composition with an aqueous continuous phase comprising i) at least one hydrophilic gelling agent present in a concentration of less than 20% by weight of the composition and ii) at least one pulverulent phase comprising at least one lamellar filler, wherein said composition has a hardness, defined by a maximum force before breaking, ranging from 5 to 130 grams, at ambient temperature, after penetration with a stainless steel spindle 2 mm in diameter into the matrix of the composition to a depth of 1 mm at a speed of 1 mm/s and removal of said spindle from the matrix of the gel at a speed of 2 mm/s.

85. (Amended) A makeup product for the body, a foundation, an eyeshadow, a face powder, a concealer, a lipstick, a lipcontour pencil, a mascara, an eyecontour pencil, a stick for dyeing locks of hair, or a stick for making up locks of hair comprising a solid composition with an aqueous continuous phase comprising i) at least one hydrophilic gelling agent present in a concentration of less than 20% by weight of the composition and ii) at least one pulverulent phase comprising at least one lamellar filler, wherein said composition has a hardness, defined by a maximum force before breaking, ranging from 5 to 130 grams, at ambient temperature, after penetration with a stainless steel spindle 2 mm in diameter into the matrix of the composition to a depth of 1 mm at a speed of 1 mm/s and removal of said spindle from the matrix of the gel at a speed of 2 mm/s. --

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